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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Timothy P. Barber  
Appl. No. : 09/873,339  
Filed : June 5, 2001  
For : ONLINE MACHINE DATA  
COLLECTION AND ARCHIVING  
PROCESS  
Examiner : Kristie D. Shingles  
Group Art Unit : 2141

CERTIFICATE OF MAILING

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

10-25-06

(Date)

John R. King, Reg. No. 34,362

SUBSTITUTE REQUEST FOR PRE-APPEAL BRIEF FILING CONFERENCE

**Mail Stop AF**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The following is substitute request for a pre-appeal brief filing conference in response to the final Office action mailed 26 June 2006, and a subsequent Advisory Action, mailed 26 September 2006. On October 13, 2006, Applicant submitted a request for a pre-appeal brief filing conference. In that request, the argument portion was only 5 pages long. The request, however, did include a page of case information bringing the total page count to 6. Out of an abundance of caution, Applicant hereby submits this substitute request which is only 5 pages long.

**REASONS FOR REQUEST**

**EXECUTIVE SUMMARY**

The Examiner has committed clear error, first in making the Office action mailed 26 June 2006 final, and also in indicating in the Advisory Action mailed 26 September 2006 that all the claims are rejected as anticipated by US application ser. no. 09/875,795 filed 6 June 2001 by David (Published as US2002/0073046), hereinafter David.

The Examiner did not, until the Advisory Action, indicate where in the prior art the Examiner has allegedly found the elements claimed in any of the claims of the application. Instead, until the Advisory Action, the Examiner referred only to disclosure in David, which is a Continuation-In-Part of US Application Ser. No. 09/500,601, hereinafter the '601 application, filed 8 Feb. 2000 and now abandoned. David and the '601 application share little if any textual similarity. Applicant made repeated requests to the Examiner to show where in the '601 application the Examiner believes the invention as claimed is to be found. In response to the final Office action, issued without the

Appl. No. : 09/873,339  
Filed : June 5, 2001

Examiner ever having shown where in the '601 application the invention is disclosed, applicant referred the Examiner to *In re Wertheim*, where the Court of Customs and Patent Appeals explained:

"If, for example, the PTO wishes to utilize against an applicant a part of [a] patent disclosure found in an application filed earlier than the date of the application which became the patent, it must demonstrate that the earlier-filed application contains Sections 120/112 support for the invention claimed in the referenced patent. For if a patent *could not* theoretically have issued the day the application was filed, it is not entitled to be used against another as 'secret prior art,' ... ." [First emphasis added; second emphasis in original.] *In re Wertheim and Mishkin*, 209 USPQ 554, 564 (CCPA, 1981).

The Examiner then issued the above-noted Advisory Action, which only indicates where in the '905 application the Examiner believes the invention as in claim 1 is disclosed, and maintained all the rejections and also the finality of the Office action mailed 26 June 2006.

Since it was not until the Advisory Action that the Examiner first pointed to where in the '905 application the invention is allegedly disclosed, the finality of the Office action ought to have been rescinded.

Secondly, as a matter of law, the claims whose elements are not alleged by the Examiner as being present in the '905 application are allowable. Further, not all of the limitations present in claim 1 are alleged by the Examiner as being disclosed in the '905 application. Thus, claim 1 also, as a matter of law, is allowable.

## **SUPPORT**

### ***Error in making final the Office action of 26 June 2006***

The Office action of June 26, 2006, should not have been made final because the Examiner had not yet indicated where in the prior art the Examiner believes the invention is disclosed, as required by *In re Wertheim* (and by 37 CFR 1.104(c)(2) (Nature of Examination, Rejection of Claims). 37 CFR 1.111 (Reply by applicant or patent owner to a non-final Office action) makes clear that there is to be a first Office action giving a chance for applicant to respond to an examination. The Office action prior to the final Office action of June 26, 2006 (i.e. the Office action mailed Dec. 13, 2005, was not an Examination as required by *In re Wertheim* and 37 CFR 1.104. The Office action of 26 June 2006 should therefore not have been made final.

### ***Error in rejecting the claims***

In the final Office action (mailed 26 June 2006), the Examiner rejects all the claims under 35 USC 102(e) as being anticipated by David. As noted, David is a continuation-in-part of the '901

Appl. No. : 09/873,339  
Filed : June 5, 2001

application, and in response to requests by the Examiner to show where in the '901 application the Examiner believes the invention is disclosed, the final Office action merely notes that:

The Examiner has reviewed the parent US application, 09/600,601, and finds support in its disclosure for the relied upon paragraphs of David used to reject the claimed limitations. Therefore in accordance with 35 USC 112 first paragraph, the cited disclosure of David does receive the priority date (February 8, 2000) of the parent US application and consequently qualifies as prior art. Applicant's arguments are therefore non-persuasive and the rejection under David is maintained. For further information, Applicant is directed to MPEP chapter 103 item (v), for further instruction in this matter.

Therefore, nowhere in any of the Office Actions (as opposed to the Advisory Action) does the Examiner ever show where the Examiner believes the invention is disclosed. The Office has not therefore, in any of the Office Actions, indicated where in the '601 application each element of each rejected claim is to be found, as required by *In re Wertheim* and 37 CFR 1.104 (and 35 USC 102).

Various of the claims were also rejected (for the first time, after two earlier Office actions not having made such rejections) under 35 USC 112, second paragraph, but those rejections were overcome in the response filed to the (non-final) Office action of Dec. 13, 2005. So until the Advisory Action, the Examiner never did show where in the '601 application the Examiner believes the invention as claimed is to be found. And in the Advisory Action, the Examiner alleges only where the elements of claim 1 are to be found, and nowhere shows where the elements of any of the other claims are to be found. Thus, at least all claims except for claim 1 ought to be allowed.

***The rejection of claim 1 by the Advisory Action is Error***

Claim 1 recites:

a) capturing a machine fingerprint that identifies an access device accessing a host computer system (and so engaging in an interaction with the host computer system, which then generates an interaction record of the interaction), wherein the machine fingerprint comprises a hashed attribute string that is a concatenation of attributes associated with the access device;

b) generating a unique interaction identification string upon the access device accessing the host computer system;

c) associating the interaction identification string with the machine fingerprint; and

d) associating the interaction identification string with the interaction record generated upon the access device accessing the host computer system.

Thus, the interaction record is linked to the machine fingerprint for the access device, and thus to the access device itself via the two different associations recited in (c) and (d) of claim 1. The

interaction record typically includes customer identifying information (actual or faked), and so the method can be used to link an access device to a customer (as indicated by the actual or faked customer identifying information). The Advisory Action asserts:

The parent application clearly teaches generating a device fingerprint files (*sic*) along with the valid components of the fingerprint file. Particularly, the disclosure of the parent application teaches generating a fingerprint for a user's PC by concatenating identifying characteristics of the user's PC including a unique ID for the user, CPU ID number, hard disk serial number, amount of RAM, BIOS version and type, etc. (Page 14, items 2 and 4). This teaching anticipates Applicant's claimed limitations for capturing a machine fingerprint that identifies said access device accessing said host computer system wherein said machine fingerprint comprises a hashed attribute string that is a concatenation of attributes of said access device.

The examiner nowhere alleges or explains where in the reference (the '601 application) there is a teaching or suggestion of any kind hashing of a concatenation of the characteristics that are used for generating a fingerprint file. Further, the examiner does not expressly indicate where in the reference the interaction record is to be found, but presumably it is the "user-provided information" that is "transparently submitted" with the "basic information" (which applicant understands to comprise the fingerprint of the reference), as explained in the reference at page 14, item 2. Assuming this is so, for the reference to teach the remaining elements of claim 1 there will have to be disclosure to the effect that the fingerprint file is associated with an interaction identification string that is generated upon the access device accessing the host computer system.

But all that is next alleged by the examiner in the Advisory Action is that:

Furthermore, the parent application teaches associating the user's PC fingerprint with other user identifying information in order for the toolbox to confirm the user along with the validity of the user's transaction and for the merchant's server to acquire the user's information (pages 4, 8 and 15; page 11 item 2; pages 16-17 items c and d; ... which further anticipates the claim limitations of generating a interaction (*sic*) identification string upon said access device accessing said host computer system; associating said interaction identification string with said machine fingerprint; and associating said interaction identification string with said interaction record generated upon said access device accessing said host computer systems.

Applicant has carefully reviewed the cited text, and nowhere can it fairly be said that the reference teaches or suggests generating a unique interaction identification string (in addition to the

Appl. No. : 09/873,339  
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user-provided information, which is all that is disclosed that can be likened to the interaction record) upon the access device accessing the host computer system, nor can it be said that the text teaches or suggests associating the interaction identification string with the machine fingerprint, since such interaction identification string is never taught or suggested as having been generated, nor can it fairly be said that the reference teaches associating the interaction identification string (because it is never generated according to the reference) with the interaction record (presumably the user-provided information of page 14, item 2) generated upon the access device accessing the host computer system. It cannot be overemphasized that the invention as in claim 1 requires generating a fingerprint formed as a hash of a concatenation of attributes associated with the access device, generating an interaction record, generating a unique interaction identification string from the interaction record, associating the interaction identification string with the fingerprint, and associating the interaction identification string with the interaction record, thus relating the interaction identification string with the interaction record. The '601 application merely disclose forming a fingerprint in some undisclosed fashion while a user completes an application for credit, and later identifying the user machine on the basis of the fingerprint. There is no disclosure of the association of an interaction identification string with an interaction record, both of which are associated with a fingerprint, as required by claim 1.

The rejection of claim 1 as in the Advisory Action is thus also error.

### **Conclusion**

For all the foregoing reasons, all the claims are believed in condition for allowance and their passage to issue is earnestly solicited. Also, please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 10-25-06

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